## REMARKS

1. Status of the Claims

Claims 1-10 are pending in this Application. By this Response, Applicant amended Claims 1-3, 5 and 10. Applicant respectfully submits no new matter was added and that the amendments are fully supported by the application as originally filed. Accordingly, Claims 1-10 are at issue.

Applicant respectfully submits that the above amendments to the claims also overcome the claim objections and the rejections under 35 U.S.C. §112, second paragraph.

2. Rejection of Claims under 35 U.S.C. 103(a)

Claims 1-2 and 4-10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,526,158 to Goldberg in view of U.S. Patent No. 6,233,399 to Walter. Applicant respectfully submits that combination of the cited references is improper, but even if proper, Applicant's invention is patentable over the combination of references.

The present invention is directed to making, viewing and optionally ordering photographic images, which are typically taken of visitors to zoos and amusement parks. After a photograph is taken with a digital camera, the image is sent wirelessly to a processing unit. A code is sent to a printing unit during processing of the digital image, and the person from whom the image is made is given a receipt with the code. Using the receipt and code, the person can view the images and decide whether to order and purchase the image. In addition, the photographer has the ability to move about, capturing images of patrons in different areas of the venue as the camera is not set up in a stationary location.

Goldberg discusses obtaining photographic images of patrons visiting theme parks. The patron is given a remote identification tag, which is decoded by readers placed at various locations in the park and images of the patrons are taken while, for example, on various rides. (col. 6, lines 25-36). Typically, the camera taking the image is located at a stationary, specific point and a trigger mechanism accompanying the camera causes the camera to take the image

when the patron is within the field of view of the camera (col. 12, lines 32-37). Identification information is matched with the electronic images that are collected and stored. The patron goes to a distribution station and using the identification tag, can view images, subsequently printing the desired images or delivering them to a video, CD or email. As noted in the Office Action, Goldberg does not disclose use of a receipt with a coded image as in the present application. Rather, Goldberg uses an identification tag associated with and worn by the patron to access the images at the distribution kiosk. (col. 6, lines 54-62). Further, Goldberg does not offer the option that the photographer can move about the venue, but rather the cameras of Goldberg are set in a stationary location for capturing images.

Walter discloses a film drop-off apparatus or kiosk, apparently designed to reduce processing and delivery time. (col. 1, lines 17-18). The apparatus includes a computer displaying instructions to the customer, including photo delivery options and times. The computer sends a message to the film laboratory with the customer's choices. (col. 1, lines 24-30). Walter is cited for the premise that a receipt is provided. However, the receipt provided in Walter is given to the customer after submission of the order and payment (col. 3, lines 5-8). The customer can use the bar code on the receipt to determine the status of his/her film development order. Providing a receipt after any purchase is standard practice. And in Walter, the receipt is not provided until **after** the purchase in made. Yet, in the present invention, the receipt with the code is not provided after a purchase, but **before** any optional purchase is made. Therefore, Applicant respectfully submits that the receipt of Walter is not the same as or even analogous to the receipt of the present invention.

Initially, combination of the references is improper as there is no motivation in the references to combine them. *See In re Napier*, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1785 (Fed. Cir. 1995). There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination of references feasible. That knowledge cannot come from the Applicant's invention itself. *See In*

*re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992) (citing *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 678-79 (Fed Cir. 1988)); *In re Geiger*, 815 F.2d 686, 687 (Fed. Cir. 1987); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1147 (Fed. Cir. 1985). "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (citing *In re Gormyan*, 933 F.2d 900, 902 (Fed. Cir. 1984)).

Certainly, this rationale is applicable in the present case. Goldberg teaches obtaining photographic images of patrons at theme parks, wherein the patron wears an identification tag that transmits a signal to readers on a stationary camera for taking images of the patron on various rides. The images are stored and can viewed by the patron at a kiosk using the tag. Because of the ability of the patron to view images using the identification tag at the remote kiosk, there is no need for any further receipt to be generated. Walter teaches a film development kiosk, wherein the customer deposits film for development and programs in the desired development options and delivery times. A receipt is provided so the customer can track the order. In Goldberg, the patron has the option to purchase photos taken while on various rides or locations in the theme park, whereas Walter, a completely unrelated reference to Goldberg, is directed to a film development kiosk. Therefore, it does not follow to combine these two very distinct, unrelated references -- Goldberg, a method for taking digital images of people at a public amusement park for later viewing and purchase, with a photo development kiosk of Walter --to arrive at Applicant's invention.

Even if the combination was proper, Applicant's invention is patentable over the combination. The present invention is directed to a system for making a recorded image with a digital camera, wherein the image is sent wirelessly to a processing unit for processing of the image. A corresponding code is provided (also wirelessly) to a printing unit, wherein the code is printed onto a receipt that is provided to the person whose image was made. Using the receipt

and code, the person can access the image and decide whether he/she wishes to purchase the image. Goldberg is directed to obtaining images of patrons at an amusement park or other venue, and providing access to the image for the person to purchase or otherwise download to another medium using an identification tag worn by the patron. Receipts are not provided to the patrons in Goldberg. Walter is directed to a film development kiosk, which is completely distinct from either Goldberg or the present invention. In Walter, the customer deposits his/her film in the kiosk, programming in development and delivery preferences. Walter is combined with Goldberg simply because Walter provides a receipt after payment for the film development; however, there is no relation of Walter to either Goldberg or the present invention. Applicant submits claims 1-2 and 4-10 are patentable over these references.

Claim 3 stands rejected as being unpatentable over Goldberg in view of Walter and further in view of US Publication 2002/0067408 to Adair et al. Applicant respectfully submits that as claim 3 includes all the limitations of claim 1, it is likewise patentable over the combination of Goldberg and Walter discussed above. If an independent claim is non-obvious under §103, then any claim depending therefrom is also non-obvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). The addition of Adair et al. does not overcome the deficiencies of the combination of Goldberg and Walter.

## CONCLUSION

In light of the foregoing reasons, Applicant respectfully requests reconsideration and allowance of claims 1-10. The Commissioner is authorized to charge any additional fees or credit any overpayments associated with this Amendment to Deposit Account 13-0206.

Respectfully submitted,

Date: January 3, 2008

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